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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/382,372	08/24/1999	JEFFRY JOVAN PHILYAW	PHLY-24738	5133

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EXAMINER	
KANG, PAUL H	

ART UNIT	PAPER NUMBER
2141	

DATE MAILED: 09/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/382,372	PHILYAW ET AL.	
	Examiner	Art Unit	
	Paul H Kang	2141	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *08 June 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1 and 2* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1 and 2* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *3/26/01* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1 and 2 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims cited below of copending Application Nos. 09/382,427 (hereafter referred to as '427) and 09/494,956 (hereafter referred to as '956).

Although the conflicting claims are not identical, they are not patentably distinct from each other because the context of the claimed invention is the same as the context of the copending application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

3. Claims 1 and 2 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-14 of U.S. Patent No. 6,594,705 B1, claims 1-27 of US Pat. No. 6,636,896 B1 and claims 1-18 of US Pat. No. 6,098,106. Although the conflicting claims are not identical, they are not patentably distinct from each other because the context of the claimed invention is the same as the context of the two commonly owned patents.

The claimed inventions in said US Patents teach the present invention substantially as claimed. However, The claimed inventions (with the exception of claims 17 and 18 of US Pat. 6,098,106) do not specifically teach in direct response to the step of connecting causing user profile information of the user to be sent to the advertiser's location over the network, receiving the user profile information at the advertiser's location, and generating advertising information to forward to the user based upon the user profile information being forwarded to the advertiser's location and forwarding this advertising information to the connected user, wherein broadcast of the audio signal causes both a connection to the advertiser's location on the network and a push of user profile information thereto.

In the same field of endeavor, Reese teaches a system for data set selection based upon user profile. Reese teaches transmitting a request that contains a user profile to a server,

receiving the profile at the server, and generating the requested information based upon the user's profile (Reese, col. 1, lines 55-63 and col. 4, lines 6-21).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have incorporated the use of content customization based on user profiles, as taught by Reese, into the automatic data retrieval system of the prior art of record for the purpose of increasing the quality and relevance of the retrieved data.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wolzien, US Pat. No. 5,761,606 in view of Hudetz et al., US Pat. No. 5,978,773 and further in view of Reese, US Pat. No. 6,374,237 B1.

5. As to claim 1, Wolzien teaches the invention substantially as claimed. Wolzien teaches receiving at a user's computer at a location on the network an audio signal from a broadcast generated by an advertiser, which audio signal has embedded therein unique coded information (Wolzien, col. 3, lines 25-49);

connecting the user's computer to an advertiser's location in response to extracting the unique coded information from the audio signal, and the advertiser's location being correlated to the unique coded information; extracting the unique coded information from the audio signal in response to the step of receiving (In response to the receipt of the audio/video signal, the system extracts the embedded electronic address for use. Wolzien, col. 3, line 25 – col. 4, line 29 and col. 6, lines 1-58).

However, Wolzien does not specifically teach connecting the user's computer to an advertiser's location without user intervention in response to the step of extracting. In the same field of endeavor, Hudetz teaches a system for automatically connecting a user to an advertiser's location based on unique coded information retrieved from an input device (Hudetz, abstract and col. 3, line 17 – col. 4, line 30 and col. 9, lines 54-64).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have incorporated the method of automatically connecting the user to an advertiser's location, as taught by Hudetz, into the system of Wolzien for the purpose of increasing efficiency and user friendliness.

Wolzien-Hudetz teach the invention substantially as claimed. However, Wolzien-Hudetz do not specifically teach in direct response to the step of connecting causing user profile information of the user to be sent to the advertiser's location over the network, receiving the user profile information at the advertiser's location, and generating advertising information to forward to the user based upon the user profile information being forwarded to the advertiser's location and forwarding this advertising information to the connected user, wherein broadcast of the

audio signal causes both a connection to the advertiser's location on the network and a push of user profile information thereto.

In the same field of endeavor, Reese teaches a system for data set selection based upon user profile. Reese teaches transmitting a request that contains a user profile to a server, receiving the profile at the server, and generating the requested information based upon the user's profile (Reese, col. 1, lines 55-63 and col. 4, lines 6-21).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have incorporated the use of content customization based on user profiles, as taught by Reese, into the automatic data retrieval system of Wolzien-Hudetz for the purpose of increasing the quality and relevance of the retrieved data.

Response to Arguments

6. Applicant's arguments with respect to claim 1 have been considered but are not deemed to be persuasive. The Applicant argued in substance that:

a. "Although there is some reference to an automatic operation in Hudetz, Applicants believe that this automatic operation is poorly disclosed and is not supported by the Specification in that an HTML must be retrieved and then the computer at the user's location must make some kind of decision thereat... Therefore, it is the combination of the broadcasting of the encoded unique code within the broadcast, the control of the computer to both 'jump' to a particular location that is known by the advertiser to be associated with that unique code and also transmission of the profile inforation top the remote location that is unique. It is this unique combination and the

way which is carried out that allow the advertiser to control the operation."

As to point a, as stated by the applicant, the prior art of record teaches automatic operation. However, contrary to applicant's view of the prior art, the examiner believes the disclosure provided for automatic operation and retrieval of information is sufficiently disclosed in the prior art to have enabled the artisan of ordinary skill in the art at the time the invention was made to make and use the invention.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul H Kang whose telephone number is (703) 308-6123. The examiner can normally be reached on 9 hour flex. First Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on (703) 305-4003. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Paul H Kang
Primary Examiner
Art Unit 2141